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EXAMINER

SOUGH, H

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/163,993

Applicant(s)

Ananda

Examiner

Huyng S. Sough

Group Art Unit

2161



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6, 7, 10, 12-14, 18-21, 23-25, 27-29, 31-34, 36, 39, and 41-81 are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4, 6, 7, 10, 12-14, 18-21, 23-25, 27-29, 31-34, 36, 39, and 41-81 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5, 7, & 8

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not support the claimed subject matter claimed in claims 74-81, i.e., "computer readable program code" configured to "submit said at least one payment to said server system software", "credit postage value corresponding to an amount of said at least one payment to a user account" or "deduct said amount from said user account". The specification states that these are done by "client system software" (see FIG. 25A). Clarification is required.

Claim Objections

2. Claims **70-73, 75 and 76** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In lines 8-9 of the independent claim 69, it recites that "adding postage value corresponding to an amount of said at least one payment to a user account." However, dependent claims recite various payment options ("*deducting said amount from said user account.*" (Claim 70, line 2), "*said deducting is performed upon authorization from said user.*" (Claim 71, lines 1-2), "*said payment comprises credit card data.*" (Claim 72, line 1),

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"said payment comprises electronic funds transfer data." (Claim 73, lines 1-2)) which cannot be used with the payment method claimed in the independent claim 69 (*i.e.*, *"adding postage value corresponding to an amount of said at least one payment to a user account."*). For the same reason, claims 75 and 76 are objected.

3. Claims **19, 20 and 33** are objected to because of the following informalities:

- Claim 19, line 2, after "print", "cancel" has been deleted without using a bracket.
- Claim 20, line 2, "comprise" should be --comprises--.
- Claim 33, line 1, "onlin" should be --on-line--.

Applicant is advised to carefully review all the claims for further needed corrections.

Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims **1-4, 6, 7, 10, 12-14, 18-21, 23-25, 27-29, 31, 66, 67, and 70-81** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1, line 9, "a request" cannot be clearly understood. More specifically, it is not clear what kind of "request" it is, e.g., "requests" for an account balance, price check, or what. Likewise, "request" in claim 10 cannot be clearly understood.

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- Claim 18, line 2, “the print spooler” does not have proper antecedent basis.
- Claim 23, line 2, “a permission” cannot be clearly understood. More specifically, it is not clear what kind of “permission” it is, e.g., “permission” to use software, to play video game, or what. Likewise, “permission” in claim 27 cannot be clearly understood.
- Claim 66 cannot be clearly understood. More specifically, it is not clear whether “user” is referring to a person or a system of a user. If “user” is referring to a system of the user, it is not clear what the differences are between “client system” and “user”.
- Claim 67 cannot be clearly understood. More specifically, it is not clear whether “said client system” and “at least one client system” are same system or not. If these are two different systems, it will expose one user’s confidential information (e.g., account number or credit card number) to the others.
- Claims 70-73, it is not clear which payment method is used. For example, in claim 70, is the payment method by “adding postage value corresponding to an amount of said at least one payment to a user account”, by “deducting said amount from said user account.” or by using both. If both payment methods are used in claim 70, it is not clear how it can be done.
- Claim 74, it is not clear what the differences are between “computer readable program code” and “client system software”. More specifically, are “computer readable program code” and “client system software” separate programs or the one (e.g., “computer readable program”) is a part of the other (e.g., “client system software). If these are two

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separate programs, the specification does not provide proper antecedent basis for the claimed subject matter for the reason stated in the paragraph 1 of this Office action.

- Claim 76, line 1, "said deducting " does not have proper antecedent basis.

Applicant is advised to carefully review all the claims for further needed corrections.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims **42, 43, 56, 68, 69-79 and 81** are rejected under 35 U.S.C. 102(e) as being anticipated by Kara (US PAT. 5,822,739).

Re claim 42: Kara discloses a secure on-line postage management method comprising:
establishing a secure continuous communication link between a client system and a
server system (*col. 6, lines 11-22*);

said client system processing a user request for obtaining an indicium (*col. 6, lines 11-22*);

said client system securely communicating said user request to said server system (*col. 6, lines 11-22*);

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said server system processing said user request (*col. 6, lines 37-43*);

said server system securely communicating to said client system a response to said user request (*col. 6, lines 11-22*);

said client system processing said response to obtain said indicium (*col. 6, lines 11-22, "decrypting the received data packet"*); and

said client system obtaining said indicium (*printing the desired postage indicia*).

Re claim 43: Kara discloses that said client system securely communicating with said server system comprises authenticating a user by establishing a secured communication link between said client system and said server system and verifying the authenticity of information exchanged; and continuously monitoring said secured communication link to verify said authenticity of information exchanged (*col. 6, lines 11-22, "utilizing cryptographic key sets"*).

Re claim 56: Kara discloses that communication between client system and server system is encrypted (*col. 6, lines 11-22*).

Re claim 68: Kara discloses maintaining a continuous communication link between said client system and said server system and retrieving said indicium from said server system (*col. 6, lines 11-22 and lines 39-43*).

Re claim 69: Kara discloses a method having steps of establishing a continuous communication link between a client system and a server system (*col. 6, lines 11-17*), wherein said client system comprises client system software ("*Demand*" program); said client system software presenting one or more options for submitting at least one payment (*col. 13, lines 31-*

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45); submitting said at least one payment to said server system software while said continuous communication link persists (*col. 13, lines 25-30 and 31-45*); and adding postage value corresponding to an amount of said at least one payment to a user account (*col. 13, lines 25-30 and 31-45, i.e., credit account for later billing*).

Re claim 70: Kara discloses the step of deducting said amount from said user account (*col. 13, lines 25-30 and 31-45, i.e., deducted from the user's debit account*).

Re claim 71: Kara discloses that said deducting is performed upon authorization from said user (*col. 13, lines 25-30 and 31-45, i.e., the user supplying certain information about the user's debit account*).

Re claim 72: Kara discloses said payment comprising credit card data (*col. 13, lines 25-30 and 31-50, i.e., bank card*).

Re claim 73: Kara discloses said payment comprising electronic funds transfer data (*col. 13, lines 25-30 and 31-50, i.e., bank card*).

Re claim 74: Kara discloses a computer program product having a computer readable medium having computer readable program code (*i.e., "a data communications program"*) embodied therein, said computer readable program code configured to: establish a continuous communication link between a client system and a server system (*col. 6, lines 11-17*), wherein said client system comprises client system software (*i.e., "Demand program"*) configured to present one or more options for submitting at least one payment (*col. 13, lines 31-45*); submit said at least one payment to said server system software while said continuous communication

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link persists (*col. 6, lines 11-17; col. 13, lines 25-30 and 31-45, i.e., "a data communication program" processes information*); and credit postage value corresponding to an amount of said at least one payment to a user account (*col. 6, lines 11-17; col. 13, lines 25-30 and 31-45, i.e., "a data communication program" processes information*).

Re claim 75: Kara discloses the computer program product comprising computer readable program code configured to deduct said amount from said user account (*col. 6, lines 11-17; col. 13, lines 25-30 and 31-45, i.e., "a data communication program" processes information and deduction from the user's debit account*).

Re claim 76: Kara discloses that said deducting is performed by said computer readable program code upon authorization from said user (*col. 6, lines 11-17; col. 13, lines 25-30 and 31-45, i.e., the user supplying certain information about the user's debit account and "a data communication program" processes information*).

Re claim 77: Kara discloses said payment comprising credit card data (*col. 13, lines 25-30 and 31-50, i.e., bank card*).

Re claim 78: Kara discloses said payment comprising electronic funds transfer data (*col. 13, lines 25-30 and 31-50, i.e., bank card*).

Re claim 79: Kara discloses that said continuous communication link utilizes Internet protocols to transfer data (*col. 15, lines 19-21*).

Re claim 81: Kara discloses data transmitted between said client system software and said server system software comprising encrypted information (*col. 6, lines 17-22*).

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Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 6, 7, 10, 12, 13, 14, 18-21, 23, 27, 32-34, 36, 39, 41, 44-55, 58, 59, 60, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (US PAT. 5,822,739).

Kara discloses a secure on-line printing method, comprising:

establishing a communication link between a first computer and a second computer
(i.e., claim 27, the step of "coupling said first system to a second processor-based system");
executing a client software on said first computer, wherein said client software initiates a continuous communication link between said first computer and said second computer *(col. 6, lines 11-17)*;
sending a request from said client software to said second computer *(i.e., claim 27, the step of "transmitting said demand from said first system to said second system")*; and
sending value-bearing-information from said second computer to said first computer in response to said request *(i.e., claim 27, the step of "transmitting said data packet from said*

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second system to said first system”), while said communication link is continuous (col. 11, lines 13-18).

Further, Kara discloses a secure on-line postage metering method comprising:

establishing a communication link between a user computer and a vendor computer
(*i.e., claim 27, the step of “coupling said first system to a second processor-based system”*);

providing a printer connected to said user computer (*printer 24*);

executing an on-line postage metering software on said user computer wherein said on-line postage metering software determines if said communication link between said first computer and said second computer is continuous (*col. 6, lines 11-17*);

said on-line postage metering software (*i.e., “Demand program”*) sending a request for a print authorization to said vendor computer (*i.e., claim 27, the step of “transmitting said demand from said first system to said second system”*);

said vendor computer accessing a database to verify fund availability to cover said request (*col. 13, lines 31-45*);

said vendor computer sending data elements for a postage indicium to said first computer as a response to said request (*i.e., claim 27, the step of “transmitting said data packet from said second system to said first system”*); and

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said on-line postage metering software sending a postage indicium graphic associated with said data elements to said printer (*i.e.*, “*Demand program*” decrypting the received data packet for printing).

Re claims 1, 18 and 19: Kara does not explicitly disclose the step of terminating said client software when said communication link is not continuous, said value-bearing information comprising disabling the print spooler of a printer connected to said first computer, or said client software sending a print cancel command to said printer when said communication link disconnects. However, the examiner takes official notice of both motive and modification necessary for these features. More specifically, these features are well known in the data processing art to transfer confidential data securely and the abrupt disconnection of a secure link signifies that there is a possibility of breaching of security transferring sensitive data. Thus, it would have been within the level of ordinary skill in the art to employ these well-known features for the system of Kara to prevent theft of confidential information (e.g., credit card or debit account number) or fraudulent use of postage.

Re claim 2: Kara discloses that said value-bearing information (*i.e.*, “*data packet*”) is used for printing an image (*i.e.*, “*postage indicia*”).

Re claims 3 and 4: Kara discloses said request and said value-bearing item information comprising encrypted data (*col. 6, lines 17-22*).

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Re claim 6: Kara discloses said value-bearing information comprising an image of a postal indicium (*col. 6, lines 40-42*).

Re claim 7: Kara discloses said request comprising a postage amount (*col. 6, lines 4-7*).

Re claim 10: Kara discloses that said sending said request is in response to a command from a user (*col. 3, lines 16-19*).

Re claims 12 and 13: Kara discloses said second computer comprising a database containing user information, wherein said user information comprises financial information associated with said user (*col. 13, lines 31-45. It is well known in the art to keep user's credit or debit account in a database*).

Re claim 14: Kara discloses said sending a request to said second computer further comprises accessing said user information to verify fund availability to cover said postage amount (*col. 13, lines 31-45*).

Re claims 20 and 21: Kara discloses said value-bearing information comprising ticket information and said request comprises a ticket price (*col. 15, lines 27-32*).

Re claims 23 and 27: Kara discloses that said second computer sends a permission to said first computer in response to said request, said second computer accessing a user's financial information to verify funds availability (*col. 13, lines 31-45. If proper funding is available, said second computer sends permission to said first computer to use the Meter program*).

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Re claims 32, 36 and 41: Kara does not explicitly disclose the step of terminating said online postage metering software when said communication link is not continuous, said on-line postage metering software disabling a print spooler of said printer, and said online postage metering software sending a print cancel command to said printer if said communication link is interrupted. However, the examiner takes official notice of both motive and modification necessary for these features. More specifically, these features are well known in the data processing art to transfer confidential data securely and the abrupt disconnection of a secure link signifies that there is a possibility of breaching of security transferring sensitive data. Thus, it would have been within the level of ordinary skill in the art to employ these well-known features for the system of Kara to prevent theft of confidential information (e.g., credit card or debit account number) or fraudulent use of postage.

Re claims 33 and 34: Kara discloses said online postage metering software sending a request comprising encrypting said request and said vendor computer sending said response comprising encrypting said response (*col. 6, lines 17-22*).

Re claim 39: Kara discloses that said on-line postage metering software sending said request for said print authorization is in response to a command from a user (*col. 3, lines 16-19*).

Re claims 44, 45, 46, 47, 48, 49, 50, 51, 52, and 53: Kara states the use of various security processes (*col. 6, lines 11-22*) without explicit disclosure of the specifically claimed features. However, the examiner takes official notice of both motive and modification

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necessary for these features. More specifically, these features are well known in the E-commerce art to prevent theft of confidential information (e.g., credit card or debit account number) or fraud. Thus, it would have been within the level of ordinary skill in the art to employ above well-known features for the system of Kara to prevent theft of confidential information (e.g., credit card or debit account number) or fraud.

Re claim 54: Kara discloses that said server system processing said user request takes place in a public network (*"the Meter program"*) and a private network (*"the bank card company" of the user*) included within said server system.

Re claim 55: Kara discloses that said public network processes (*"preparing data packet" by the "Meter program"*) user requests independently from a said private network (*col. 13, lines 49-50, "credit account maintained at the local site and transmitted with the indicia request"*) to protect the integrity of said server system.

Re claim 58: Kara does not explicitly disclose the step of disabling said client system from obtaining said indicium if said secure and continuous communication between client system and server system is discontinued. However, the examiner takes official notice of both motive and modification necessary for this feature. More specifically, these features are well known in the data processing art to transfer confidential data securely and the abrupt disconnection of a secure link signifies that there is a possibility of breaching of security transferring sensitive data. Thus, it would have been within the level of ordinary skill in the art

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to employ these well-known features for the system of Kara to prevent theft of confidential information (e.g., credit card or debit account number) or fraudulent use of postage.

Re claim 59: Kara discloses that said private network processes user requests for making payments (*col. 13, lines 49-50, "credit account maintained at the local site and transmitted with the indicia request"*).

Re claim 60: Kara discloses that said private network processes user requests for making payments further comprises communicating with a financial management system for verification of availability of funds and fund transfer (*col. 13, lines 49-50, "credit account maintained at the local site and transmitted with the indicia request"*) . . .

Re claim 80: Kara does not explicitly disclose that said client system software prohibits transmission if said continuous communication link fails authentication. However, the examiner takes official notice of both motive and modification necessary for this feature, More specifically, this feature is well known in the data processing art to transfer confidential data securely and the failure of authentication signifies that there is a possibility of transferring sensitive data to a wrong place or security breach of the communication link and it would have been within the level of ordinary skill in the art to employ this well known feature for the system of Kara to prevent theft of confidential information (e.g., credit card or debit account number).

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10. Claims **24, 25, 28, 29 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Edelmann et al. (Edelmann hereinafter: US PAT. 4,775,246).

Kara states that his invention "may be utilized to transmit any form of indicia." (Col. 15, lines 25-26) without explicitly disclosing the value-bearing information comprising check information, coupon information or certificate information and the request comprising a check amount or a coupon amount. However, Edelmann shows various form of indicia (*e.g.*, *postage, parcel service, tax stamps, checks writing, ticket, and other similar indicia: col. 5, lines 17-23*). Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Kara by employing the value-bearing information comprising any known indicia as shown by Edelmann as desired to detect fraudulent imprints on documents that require verification and authentication of a user.

11. Claims **57 and 61-67** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara in view of Information Based Indicia Program System Specification (IBIPSS hereinafter: October 9, 1996, The United states postal Service).

Kara discloses an on-line postage system for processing of user requests and obtaining postage indicia comprising:

a client system (*a first processor-based system*) for interfacing with a user;

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a server system (*a second processor-based system*) in continuous and secure communication with said client system, comprising (*col. 6, lines 11-22*):

a communication server for communicating with client system (*col. 7, lines 18-36*);

a database server for storing user information (*col. 14, lines 24-30*);

a transaction server for processing of requests communicated to said server system by said client system (*col. 14, lines*);

a cryptographic device for encrypting communication between said client system and said server system (*col. 6, lines 20-23, i.e., "decrypting the received data packet" implies that the second processor-based system must have a cryptographic device*);

a communication link with a financial management system for processing user payments (*col. 13, lines 45-50, i.e., "the provider will demand payment from the bank card company concurrent with the postage demand."*).

Re claim 57: Kara does not explicitly disclose that communication between client system and server system is encrypted by a United States Postal Service compliant cryptographic device. However, as shown by IBIPSS (*see page 3-13, section 3.2.6.3*), the open system server shall prompt the user to apply (*register*) for a postage meter license and update the license as required by the DMM. Thus, it would have been obvious to one of ordinary skill in the art to employ the client system and server system being encrypted by a United States Postal Service compliant cryptographic device to establish a communication link

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with the United States Postal Service Central Meter Licensing System (USPS CMLS) for licensing of a user to satisfy the requirement.

Re claims 61 and 62: Kara does not explicitly disclose that said server system communicating with the United States Postal Service Central Meter Licensing System (USPS CMLS) for processing of user licensing information. However, as shown by IBIPSS (*see page 3-13, section 3.2.6.3*), the open system server shall prompt the user to apply (*register*) for a postage meter license and update the license as required by the DMM. Thus, it would have been obvious to one of ordinary skill in the art to establish a communication link with the United States Postal Service Central Meter Licensing System (USPS CMLS) for licensing of a user to satisfy the requirement.

Re claim 63: Kara does not explicitly disclose either a firewall for ensuring the integrity of said server system against potential unauthorized access or a communication link with the United States Postal Service Central Meter Licensing System (USPS CMLS) for licensing of a user. However, as shown by IBIPSS (*see page 3-13, section 3.2.6.3*), the open system server shall prompt the user to apply for a postage meter license and update the license as required by the DMM. Thus, it would have been obvious to one of ordinary skill in the art to establish a communication link with the United States Postal Service Central Meter Licensing System (USPS CMLS) for licensing of a user to satisfy the requirement. Further, Kara states that the server system can be used by a plurality of remotely located client systems and the client system provides security system to prevent unauthorized utilization of the

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postage metering system (*col. 4, lines 36-51*). Of course, a firewall is one of the well-known security systems in the art and the use of this well known feature at the server system would have been within the level of ordinary skill in the art, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Re claim 64: IBIPSS disclose the use of a system software down-loadable from said server system to said client system (*see page 3-3, section 3.2.1.1*) to ensure the proper installation and configuration of the user system. Thus, it would have been obvious to one of ordinary skill in the art to modify the system of Kara by adopting the teaching of IBIPSS to ensure the proper installation and configuration of the client system.

Re claim 65: Kara discloses that said server system is accessible through an Internet portal (*col. 7, lines 25-27*).

Re claim 66: Kara discloses that said client system interfaces with at least one user (*col. 1, lines 22-29*).

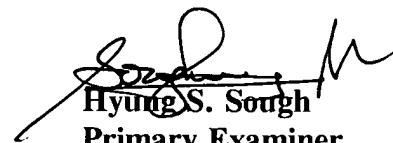
Re claim 67: Kara discloses that said client system comprises administration software (*i.e., a data communications program*) to monitor (*i.e., to maintaining a link, the data communication program has to monitor the system*) at least one client system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax number is (703) 308-1396.



Hyung S. Soug
Primary Examiner
Art Unit 2161

shs
March 10, 2001